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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, MAIKHANH	
ART UNIT	**PAPER NUMBER**
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/726,917	PEIRO ET AL.	
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) *13-24 and 36-41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 25-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communication: Response to Election / Restriction filed 12/27/2006 to the original application filed 12/03/2003.

Claims 1-12 and 25-35 are presented for examination. Claims 1 and 25 are independent claims. Claims 13-24 and 36-41 are withdrawn from consideration.

Applicant is required to cancel non-elected claims 13-24 and 36-41 in the next response to this office action.

Election/Restrictions

2. Applicant's election with traverse of Group I (claims 1-12 and 25-35) in the reply filed on 12/27/2006 is acknowledged. The traversal is on the ground (s) that *even if appropriate reason exist for requiring restriction, such a requirement should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application.* This is not found persuasive because of the fact that the embodiments may be searched together cannot preclude a requirement for restriction if their appearances are considered patentably distinct, since patentably distinct embodiments cannot be supported by a single formal design claim, the first group is drawn to *producing an optimized PDF*

document from the PPML template wherein subsequent instances of a PDF object will be substituted with references to an initial instance of the PDF object, the second group is drawn to *marking a copy the initial PDF document to indicate variable objects, thereby forming a marked PDF document*, the third group is drawn to *selecting objects within a PDF document for designation as variable objects within a PPML template*, the fourth group is drawn to *printing the PPML document using a digital press*, and the fifth group is drawn to interpreting the parsed structures from the PPML document into locations on the PDF document tree, which are specifically classified in two different subclasses 715/513, 715/526, 715/762, 358/1.1, and 715/523, respectively. Thus, the requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-12 and 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over **Kloosterman et al.** (US 2003/0189726, filed 04/09/2002) in view of **Gebert et al.** (US 2002/0111963, filed 02/14/2001).

As to claim 1:

Kloosterman teaches a processor-readable medium comprising processor-executable instructions for processing a PDF document to produce a PPML template *[see the Abstract and the discussion beginning at ¶¶ 0017 and 0109]*, the processor-executable instructions comprising instructions for:

- opening the PDF document *(e.g., open PDF based workflow architecture that recognizes the importance of, and supports, the de-coupling of VDP authoring and VDP print production; see ¶ 0040 /accessible PDF object stream that is stored within a PDF file; see ¶ 0012 & the viewing of single PDF objects ... view the file as a randomly accessible list of PDF objects is selected; see ¶ 0050)*;

- selecting a macro containing rules governing operation of the variable object [e.g., *generates a single Instance Document by using the template containing static and variable images, graphics and text. Merge 14 applies the static objects to each of the Instance Documents using the rules as defined by the author for the inclusion of variable objects ... applies the rules that were given by the author during the authoring process which results in the system going to the recipient database*" (see ¶ *0039); "a set of rules for mapping the pages of Instance Documents for a*

single VDP Family on to sheets of media that are known to the selected device" (see ¶ *0119); and "The graphical artist creates a template consisting of static images, graphics and text as well as variable images, graphics and text in VDP composition 12. The variable parts of the layout will have an associated set of rules that describe the procedures necessary to create each Instance Document" (see ¶ 0033)]*; and

- configuring the PPML template to include a definition of the variable object and a version of the PDF document, wherein the version of the PDF document is configured as a background element within the PPML template *(e.g., The data format required by the PPML/VDX standard for defining the compound element source data is the Adobe Portable Document Format defined and maintained by Adobe Systems.RTM. In PPML/VDX, the source PDL data that defines a compound element that is placed on a PPML defined page layout is always expressed as a page of a PDF file. PDF files used to define PPML/VDX compound elements must contain all the supporting resources such as fonts, image data, and color profiles. PDF files used to define PPML/VDX compound elements must also define all color content in a known reference device or device independent color-space; see ¶ 0011 and 0033).*

Kloosterman does not specifically teach the converting step as claimed.

Gebert teaches the use of converting a PDF element within the PDF document into a variable object *(see the Abstract, see ¶ ¶ 0034-0036, and 0044).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kloosterman with Gebert because Gebert's teaching would have enhanced variable data printing practice within the printing industry and facilitated the production of Variable Data Printing Jobs.

As to claim 2:

Kloosterman providing a tool for operation by a user *(e.g., a tool that can be used by the prepress operator during prepress 20 to optimally manufacture the VDP print job as described from the job produce; ¶ 0040)* and responding to operations of the tool which result in a selection of a portion of the PDF document to be associated with the variable object (*¶ 0050).*

As to claim 3:

Kloosterman teaches selecting a graphical image *(e.g., graphics)* within the PDF document *[see the discussions beginning at ¶ 0040].*

As to claim 4:

Kloosterman teaches selecting text *(e.g., text)* within the PDF document *[see the discussions beginning at ¶ 0040].*

As to claim 5:

Kloosterman teaches providing the user with a first set of properties for graphical objects and a second set of properties for text objects; allowing the user to adjust the properties; and governing conversion of the PDF element within the PDF document into the variable object according to the properties *(e.g., creating templates to be used in variable data printing wherein a file is provided to a printing device containing parameters relative to a print job from which a plurality of categories are formed from parameters within the file. Production parameters are created for each of the categories within the categories. A list of manufacturing capabilities is obtained from the printing device) [see the discussions in ¶ ¶0019, 0033, and 0040].*

As to claim 6:

Kloosterman teaches configuring the macro as an XML filed (see ¶ ¶ *0044 and 0101),* but does not teach the use of macros described by an SXL schema.

Gebert teaches macros described by an SXL schema (see ¶¶*0005, 0007, 0010, and 0023).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kloosterman with Gebert because Gebert's teaching would have enhanced variable data printing practice within the printing industry and facilitated the production of Variable Data Printing Jobs.

As to claim 7:

Kloosterman does not specifically the use of an external XSLT macro file.

Gebert teaches the use of an external XSLT macro file (see ¶¶ *0025-0028, 0030, and 0044).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kloosterman with Gebert because Gebert's teaching would have enhanced variable data printing practice within the printing industry and facilitated the production of Variable Data Printing Jobs.

As to claim 8:

Kloosterman teaches configuring the file to, among other things, regulate text scaling within the variable object *(e.g., the prepress 20 component will provide a set of tools to analyze, view, and prepare the VDP Job for the production 30. During production 30, the raster image processor (RIP) 32 will convert the code for each text and graphics element on every page into a format that can be printed by the print engine; see ¶ ¶0040-0042).*

As to claim 9:

Kloosterman teaches modifying the PDF document to include marking elements to link the variable object with the file *[see the discussions beginning at ¶ 0039].*

As to claim 10:

Kloosterman teaches referencing the PDF document as a background PPML asset from within the PPML template; listing, within the PPML template, fonts required within the PPML template; configuring the PPML template to include at least one file; and defining the variable object as REUSABLE within the PPML template to allow reuse of the variable object when references indicating such use appear *(e.g., The data format required by the PPML/VDX standard for defining the compound element source data is the Adobe Portable Document Format defined and maintained by Adobe Systems. In PPML/VDX, the source PDL data that defines a compound element that is placed on a PPML defined page layout is always expressed as a page of a PDF file. PDF files used to define PPML/VDX compound elements must contain all the supporting resources such as fonts, image data, and color profiles. PDF files used to define PPML/VDX compound elements must also define all color content in a known reference device or device independent color-space; see ¶¶ 0011, 0033, and 0054).*

As to claim 11:

Kloosterman teaches saving the PPML template as an optimized tree-structure *(e.g., A page definition mark up language, called Personalized Print Markup Language 'PPML', developed by the Print On Demand Initiative is an example of a data format that can represent the layout of the pages of the many unique Instance Documents of a variable data print job. PPML is based on the Extensible Markup Language and is structured in*

such a way that content data that is used multiple times under the same rendering context on one or more pages is explicitly identified so as to enable a consuming RIP process opportunities for improved processing performance; see ¶ 0008); and using a PPML to PDF converter to produce an optimized PDF document from the PPML template wherein subsequent instances of a PDF object will be substituted with references to an initial instance of the PDF object (*see the discussions in ¶¶ 0039-0043).*

As to claim 12:

Kloosterman teaches presenting a user with a choice between .pplm and .ppmlt as an extension for addition to a file name; and saving a PPML document resulting from the PDF document under the file name with the extension (*see the discussions in ¶¶ 0008, 0031 and 0097-0099]*

As to claims 25-31 and 33-35:

Note the rejection of claims 1-7 and 9-11 above. Claims 25-31 and 33-35 are the same as claims 1-7 and 9-11, except claims 25-31 and 33-35 are system claims and claims 1-7 and 9-11 are medium claims.

As to claim 32:

Kloosterman teaches rules for regulating text scaling within the variable object; rules for regulating text wrapping within the variable object; rules for regulating image scaling

within the variable object; and rules for regulating image cropping within the variable object *(e.g., see the rules discussion beginning at ¶ 0033).*

Response to Arguments

4. Applicant's arguments filed 09/05/2006 have been fully considered but they are not persuasive.

Applicant argues in substance that *Kloosterman does not teach converting a PDF element into a variable object and configuring a PPML with a definition of that variable object* [Remarks, page 18].

In response, the Examiner respectfully submits that the rejection above shows how the combination of Kloosterman and the newly applied prior art (Gebert) meets the claim limitations.

Conclusion

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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